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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,503	04/21/2004	Hirohisa Suzuki	AI 338	4304
7590 RABIN & BERDO, P.C. Suite 500 1101 14th Street, N.W. Washington, DC 20005		09/05/2007	EXAMINER MCCREARY, LEONARD	
			ART UNIT 3616	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,503

Applicant(s)

SUZUKI ET AL.

Examiner

Leonard J. McCreary, Jr.

Art Unit

3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not disclose a cylindrical main body "being formed as a single cylinder," as required by claim 1.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Amended claim 1 recites "a cylindrical main body... ***being formed as a single cylinder***" in claim 1 (emphasis added). The language was originally interpreted broadly as "substantially cylindrical," however the present amendment relies upon the definition of "cylindrical" and "cylinder" to define over the disclosure of Grafenstein, thereby defining over the scope of the present application because the specification lacks antecedent basis for the terminology, and further it is unclear how the instant device shown in applicant's drawings can be considered "cylindrical" while the device of Grafenstein cannot.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5 and 11 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 5,492,338 to Grafenstein. Grafenstein discloses a hollow elastic seal comprising the following:

a. A column hole cover 4 interposed between a circumferential portion of an aperture of a column hole formed at an instrument panel 1 for insertion of a steering column 16 therethrough and a steering gear box 2 capable of being displaced in a predetermined direction, the column hole cover comprising: a cylindrical main body 5 extended in the predetermined direction, and being formed as a single cylinder having a center axis, the single cylinder of the main body including a first annular end portion 8 directly or indirectly fixed to the steering gear box, a second annular end portion (see Figure A of this Action), and an intermediate portion (see Figure A of this Action) between the first and second end portions, the second end portion including an annular seal, the intermediate portion including an expandable/contractible portion capable of being elastically expanded or contracted in the predetermined direction, wherein, irrespective of the displacement of the steering gear box, the annular seal is maintained in an elastic pressure contact against the circumferential portion of

Art Unit: 3616

the aperture of the instrument panel by a reaction force of the compressed expandable/contractible portion (col 1, lin 39-50) (claim 1.)

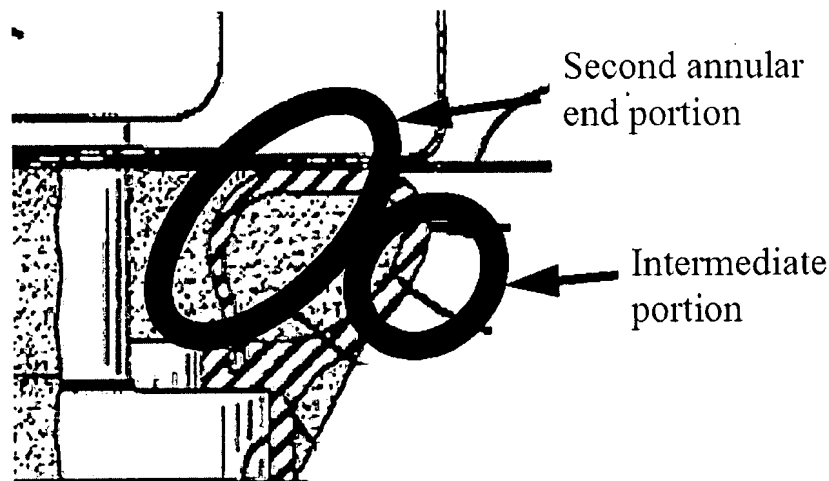


Figure A

- b. The annular seal is slidably movable along the circumferential portion of the aperture of the instrument panel in association with the displacement of the steering gear box (claim 2.)
- c. The maximum compressible amount of the expandable/contractible portion is designed to be greater than the maximum displacement of the steering gear box (col 1, lin 39-50) (claim 3.)
- d. The expandable/contractible portion has a predetermined amount of compression when the steering gear box is located farthest away from the circumferential portion of the aperture of the instrument panel (col 1, lin 39-50) (claim 4.)

- e. The annular seal including an annular flange, the annular flange including a confronting face in face-to-face relation with the circumferential portion of the aperture 12 of the instrument panel, the confronting face of the annular flange including at least one annular seal lip (fig. 1) (claim 5.)
- f. The expandable/contractible portion includes a bellows (claim 11.)
- g. The first end portion defines a first terminal edge of the single cylinder, and the second end defines a second terminal edge of the single cylinder (fig A above) (clm 18).
- h. The first and second end portions of the main body are end portions with respect to an axial direction of the main body (fig A above) (clm 19).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,492,338 to Grafenstein. The disclosure of Gradenstein is discussed above. Gradenstein does not teach specific materials beyond the example of an elastomer (col 1, lin 56-57.) Re claims 12-14, it would have been an obvious matter of design choice construct the elastic seal of Grafenstein using elastomers such as rubbers since applicant has not disclosed that the claimed materials solve any stated problem or is for

Art Unit: 3616

any particular purpose and it appears that the apparatus would function equally as well with other elastomers. Further, as elastomers are naturally- or synthetically-occurring elastic substances, it would have been obvious to one of ordinary skill in the art at the time of invention to use any one of various types of rubbers to construct the elastic seal so as to impart a resilient force at the sealing surface. Re claim 15, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the elastic seal of Grafenstein to include a spacer between the steering gear box and the first end portion of the main body so as to accommodate installation of the apparatus on various model vehicles having different geometries.

5. Claims 6 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,492,338 to Grafenstein in view of US 6,056,297 to Harkrader et al. The disclosure of Grafenstein is discussed above. Grafenstein teaches neither a circumferential portion reduced in thickness having a plurality of annular seal lips, nor an inclined portion. Harkrader discloses an intermediate shaft dash panel seal and teaches the following:

- i. The annular flange including an outside circumference portion 39 relatively reduced in thickness (claim 6.)
- j. The annular seal includes a skirt portion 30, an outside circumference of which is inclined relative to a plane orthogonal to an axis along the predetermined direction (fig. 2) (claim 10.)

Re claim 6, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the elastic seal of Grafenstein to include the outside circumference

Art Unit: 3616

portion relatively reduced thickness as taught by Harkrader so as to provide a seal against water, fumes, and dirt (col 1, lin 58-65.) Re claim 10, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the elastic seal of Gradenstein to include a relatively angular portion as taught by Harkrader so as to accommodate universal installation in various vehicle models having different geometries (col 2, lin 4-5.)

6. Claims 8-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,492,338 to Grafenstein in view of US 2,906,552 to White. The disclosure of Grafenstein is discussed above. Gradenstein does not teach a low-friction sealing surface. White discloses a sealing device having low-friction sealing faces. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the elastic seal of Gradenstein to include the low-friction sealing faces as taught by White so as to prevent friction-induced deterioration of the elastomeric seal body (col 1, lin 15-26.) Re claim 9, it would have been an obvious matter of design choice construct the elastic seal of Grafenstein using a low-friction material such as a silicone resin, PTFE, or any other material that is similarly old and well-known in the sealing art so as to facilitate assembly and to further protect against friction-induced deterioration of the sealing faces.

Allowable Subject Matter

7. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 26 June 2007 re claims 1-15 have been fully considered but they are not persuasive. Applicant argues Grafenstein does not disclose "a cylindrical main body formed as a single cylinder having a center axis." Examiner disagrees and notes that – as broadly claimed - the main body of Grafenstein comprises "a cylindrical main body formed as a single cylinder having a center axis" as much as the Applicant's main body, and Examiner further notes that the language of claim 1 does not exclude a second cylinder as Applicant implies.

8. Applicant's arguments with respect to claim 17 have been fully considered and are persuasive. The rejection of claim 17 re the Fischer reference has been withdrawn.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard J. McCreary, Jr. whose telephone number is 571-272-8766. The examiner can normally be reached on 0700-1700 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 571-272-6669. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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Art Unit 3616